

REMARKS

Claims 1-27 are pending in the present application. Claims 1, 6, 11-13, 19, and 25-27 are independent claims.

WITHDRAWN OBJECTIONS/REJECTIONS

Applicants acknowledge the Examiner's withdrawal of the objection to the specification, the objection to claim 8, and the rejection of claims 3, 8, and 12 under 35 U.S.C. §112, second paragraph.

**35 U.S.C. §103(a) MOGHADAM ET AL./CAMERON ET AL./
PC MAGAZINE ONLINE REJECTION**

Claims 1-3, 5-8, 10, 12, 13-21, and 23-27 under 35 U.S.C. §103(a) as being unpatentable over Moghadam et al. in view of Cameron et al. and further in view of PC Magazine Online ("Photo Finishing on the Web", dated September 17, 1996). This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed for the following reasons.

In Applicants' previous Response of March 12, 1999, Applicants distinguished their invention from the combination of Moghadam et al. and Cameron et al. by asserting that Moghadam et al. only transmits index files 84 and not the entire high resolution image picture. As set forth in paragraph 6 of the Office Action mailed June 8, 1999, the Examiner concurs with Applicants'

assessment of Moghadam et al. stating the "Examiner agrees that 'Moghadam only transmits index files...and not the entire high resolution picture'".

In order to make up for this deficiency, the Examiner relies on a new publication, "PhotoFinishing on the Web" PC Magazine Online dated September 17, 1996 which discusses the use of "high resolution picture image data". The Examiners asserts that one of ordinary skill in the art would be motivated to combine the high resolution picture image data of the PC Magazine Online publication with the picture print order system of Moghadam et al. "in order to provide customers with higher quality photographic images to ensure that the photograph selected for order would appear similar to the actual photograph the customer would receive." (paragraph 7, lines 4-8 of the June 8, 1999 Office Action).

Picking and choosing elements from various publications, utilizing an inventor's disclosure as a blueprint, to defeat patentability is the essence of hindsight, and is impermissible. *Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 547 (Fed. Cir. 1985).

The suggestion or motivation to combine references more often than not comes from the teachings of the pertinent references. *In re Rouffet*, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). Further, the suggestion or motivation must be clear and particular. *C.R. Bard Inc. v. M3 Systems, Inc.*, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). Broad conclusory statements regarding the teaching of

multiple references is not permitted. McElmurry v. Arkansas Power & Light Company, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Applicants respectfully submit that the Examiner's supplied motivation for combining the high resolution picture image data of PC Magazine Online publication with the picture print order system of Moghadam et al. "to provide customers with higher quality photographic images in order to ensure that the photograph selected for order would appear similar to the actual photographs the customer would receive" is a broad conclusory statement which is not permitted by McElmurry, supra. The Examiner's alleged motivation is neither clear nor particular, as required by Bard, supra, in that the Examiner's motivation could be utilized to combine literally thousands of publications, not necessarily the two (Moghadam et al. and PC Magazine Online) the Examiner relies on.

Finally, Applicants respectfully submit that the Examiner's supplied motivation, can be found in none of Moghadam et al., the PC Magazine Online publication, or Cameron et al., as set forth in Rouffet, supra. As a result, Applicants respectfully submit that the Examiner has merely pieced together Applicants' invention from various publications, utilizing the Applicants' disclosure as a blueprint, which as set forth above, is impermissible under Interconnect, supra. Accordingly, Applicants respectfully submit that the Examiner has failed to establish a proper *prima facie* case of obviousness

under 35 U.S.C. §103(a) by failing to provide proper motivation for combining the various relied-upon publications. Accordingly, Applicants respectfully request withdrawal of this rejection for all of claims 1-27 on this basis.

As previously set forth in Applicants' Response of March 12, 1999, one of the advantages of the present invention as recited in claims 1-27 is that the user is able to perform a wide variety of editing functions which can influence his/her print order. None of the references relied upon by the Examiner recognize this advantage. Applicants respectfully submit that claims 1-27 are allowable for at least this additional reason.

Finally, Applicants respectfully submit that the combination of references relied upon by the Examiner does not teach a system in which a final product is produced in a laboratory in accordance with an order from a customer to carry out editing operations (such as trimming and montage). Applicants respectfully submit that claims 1-27 are allowable for at least this additional reason.

CONCLUSION

In view of the above remarks reconsideration of the various rejections and allowance of claims 1-27 is respectfully requested.

The Examiner is respectfully requested to enter this Amendment After Final in that it presents no new issues, the claims merely being amended to

incorporate features previously presented and considered and thus place them in condition for allowance.

In the alternative, the Examiner is respectfully requested to enter this Amendment After Final in that it reduces the issues for appeal.

The amendments presented in the response are for the purpose of placing the application in better form for U.S. practice with the exception of the amended feature emphasized above in the traversal of the art rejections.

In the event that there are any outstanding matters remaining in the present application, the Examiner is invited to contact John A. Castellano at (703) 205-8000 in the Washington, D.C. area, to discuss this application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. 1.16 or under 37 C.F.R. 1.17; particularly, extension of time fees.



Respectfully submitted,

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